

REMARKS

In the Specification:

The Examiner objected to the disclosure under MPEP § 608.01 because it contains embedded hyperlinks and/or other forms of browser-executable code. Per the Examiner's request, and in compliance with MPEP § 608.01, Applicant has deleted the embedded hyperlinks and/or other forms of browser-executable code. Therefore, Applicant respectfully requests that this ground of objection be withdrawn.

In the Claims:

Claims 1-21 and 27 are cancelled without prejudice or disclaimer.

Claim 22 is amended to clarify that the claimed antibody is isolated and specifically binds an epitope of a polypeptide shown in Figure 18 (SEQ ID NO: 42), wherein the polypeptide inhibits neoplastic growth in tumor cells and wherein specifically binding that epitope prevents inhibition of neoplastic growth in tumor cells. This amendment is supported in the specification at page 31, lines 9-15, page 33, lines 11-20, and on page 138, beginning at line 13. Claims 23-26 are modified accordingly as they depend from Claim 22.

Claim 25 is amended by Examiner's request to clarify syntax.

Claims 28-30 are newly added. New claims 28-30 do not encompass new matter and are supported in the specification beginning at page 89, line 7 and page 138, line 13.

Potential Double Patenting:

The Examiner noted that SEQ ID NO: 42 of the instant application is identical to SEQ ID NO: 362 in other filings by Applicant and raised a question regarding double patenting. Pursuant to 37 CFR § 1.105 as cited by the Examiner, Applicant avers that, to the best of its knowledge, no claims of the present application conflict with claims presented in applications containing SEQ ID NO: 362.

Claim Rejections:

35 U.S.C. § 102

Claims 22-31 and 33-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by Sheppard et al., U.S. Patent No. 6,197,930. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131.01. As amended, all claims of the present application recite – or depend from claims that recite – a functional limitation not found in the Sheppard patent. Namely, the claimed antibody specifically binds to an epitope of a polypeptide shown in Figure 18 (SEQ ID NO:42), wherein that polypeptide inhibits neoplastic growth in tumor cells, and binding of that epitope prevents inhibition of neoplastic growth in tumor cells. Since the Sheppard reference does not teach either inhibition of neoplastic growth in tumor cells, nor binding an epitope which prevents inhibition of neoplastic growth in tumor cells, it does not anticipate the claims currently before the Examiner. Therefore, Applicant submits that the grounds for the anticipation rejection have been overcome and request that the Examiner withdraw the § 102 rejection.

35 U.S.C. § 101

Claims 22 and 27 were rejected under 35 U.S.C. § 101 because the Examiner alleged the claimed invention is directed to non-statutory subject matter as an antibody of this application could be found in nature. Claim 27 is cancelled without disclaimer or prejudice. Per the Examiner’s suggestion, Claim 22 has been amended to recite an “isolated antibody.” Accordingly, the § 101 rejection has been overcome and Applicant requests that it be withdrawn.

35 U.S.C. § 112, second paragraph

Claims 22-27 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 27 is cancelled without disclaimer or prejudice. Claim 22 has been

Appl. No. 09/943,851
Response dated December 9, 2003
Reply to Office Action of September 9, 2003

amended to clarify that the claimed antibody specifically binds to a polypeptide (SEQ ID NO: 42) that inhibits neoplastic growth in tumor cells. The Examiner contends that the term "specifically binds" is not clear. Applicant respectfully disagrees. The phrase "specifically binds" is a term of art that has a well-understood meaning in the art. Moreover, "specifically binds" is used throughout the specification in context, including on page 16, lines 1-3 and page 88, lines 13-15.

Accordingly, Applicant submits that it has overcome the rejection for indefiniteness of pending Claims 22-26 and requests that the rejection of those claims be withdrawn.

Appl. No. 09/943,851
Response dated December 9, 2003
Reply to Office Action of September 9, 2003

CONCLUSION

Applicant believes that currently pending Claims 22-26 and 28-30 are patentable.
Applicant respectfully requests the Examiner grant early allowance of this application.
The Examiner is invited to contact the undersigned attorney for the Applicant via
telephone if such communication would expedite this application.

Respectfully submitted,

C. Noel Kaman
C. Noel Kaman
Registration No. 51,857

Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200